

Application No. 10/670,357

IN THE DRAWINGS:

The attached formal drawing of Figure 2 has been amended to replace the label "15" with "14" and is labeled "Replacement Sheet" and accompanied by a Letter to the Official Draftsperson.

REMARKS

Claim Rejections

Claims 2 and 3 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Boldin (2006/0033714). Claims 2-3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Boldin.

Drawings

The Examiner has objected to the drawings under 37 1.121(d) because in Figure 2 element 15 should be changed to element 14. In response, Applicant encloses herewith a corrected Figure 2 along with a Letter to the Official Draftsperson.

Claim Amendments

By this Amendment, Applicant has canceled claim 1 and has added new claims 4 and 5 to this application. Claims 2 and 3 have been amended in response to the Examiner's rejections under 35 U.S.C. §112, second paragraph. It is believed that the new and amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art.

The new claims are directed toward: a hot key mouse including, *inter alia*, a scroll wheel **with hot keys on either side, as well as above and below**.

Other embodiments of the present invention further include: a hot key mouse having hot keys and mouse buttons configured to fit either a left or right hand user; and a hot key mouse having hot keys positioned as petals radiating outwards from the scroll wheel.

Boldin teaches a mouse 100 having a primary button 105 and a secondary button 106 with a wheel button 123 there between. Two additional buttons 129, and 130 are **positioned rearward** of the primary and secondary buttons 105, 106, which are located in moulds 117 and 118 forming fingertip receptacles on the upper surface of the primary and secondary buttons, respectively. See, Fig.1 and

paragraphs 37-38. It is important to note that both buttons 129 and 130 are shown as **adjacent to** wheel button 123 and not **above or below** the wheel.

The Examiner has argued on p. 4 of the outstanding Office Action, that the Boldin discloses hot keys positioned are radiating petals by teaching "hot keys formed in the shapes of the distal phalange of the user's index finger and user's middle finger, respectively (see 0055, lines 7-10, this feature related to the shapes of radiated petals as claimed by the invention)." Applicant traverses by noting that a disclosure teaching keys conforming to the distal phalange (i.e., the finger tips as shown in Boldin's Fig. 4-4B) of the user's middle or index finger does not teach hot keys above, below, and on either side of a scroll wheel (e.g., in the shape of a radiating petals).

Boldin does not teach: a hot key mouse including a scroll wheel with hot keys on either side, as well as above and below. Boldin also fails to teach: a hot key mouse having hot keys and mouse buttons configured to fit either a left or right hand user; and a hot key mouse having hot keys positioned as petals radiating outwards from the scroll wheel.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Boldin do not disclose each and every feature of Applicant's new and amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Boldin cannot be said to anticipate any of Applicant's new or amended claims under 35 U.S.C. § 102.

Even if the teachings of Boldin were modified, as suggested by the Examiner, the resultant combination does not suggest: a hot key mouse including a scroll wheel with hot keys on either side, as well as above and below.

Nor does the modified reference suggest: a hot key mouse having hot keys and mouse buttons configured to fit either a left or right hand user; and a hot key mouse having hot keys positioned as petals radiating outwards from the scroll wheel.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents

on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in Boldin that its specific teachings may be modified as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Boldin fails to disclose, or suggest a modification of its specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no modification of the cited prior art renders obvious Applicant's new claims.


Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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